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10/038,293	01/02/2002	Arnold B. Finestone	82017-1399	1249

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

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DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,293

Applicant(s)

FINESTONE ET AL.

Examiner

Walter B Aughenbaugh

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-- Th MAILING DATE of this communication appears on th cover sheet with th correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made to the title given on page 1 of Paper 5 have been received and considered by Examiner.
2. The substitute abstract attached to Paper 5 has been received and considered by Examiner.
3. The cancellation of claims 1-11 in Paper 5 has been acknowledged by Examiner.
4. The amendments made in claims 12 and 15-20 given on pages 2-3 of Paper 5 have been received and considered by Examiner.
5. New claims 21-25 presented on page 3 of Paper 5 have been received and considered by Examiner.

WITHDRAWN OBJECTIONS

6. The objection to the abstract made of record in paragraph 6 of Paper 4 has been withdrawn due to Applicant's submission of a substitute abstract in Paper 5.

WITHDRAWN REJECTIONS

7. The 35 U.S.C. 112 rejection to claim 12 has been withdrawn due to Applicant's arguments in regard to the "capable of" recitation on page 4 of Paper 5 and due to Applicant's amendments in Paper 5 in regard to the remainder of the reasons for rejection under 35 U.S.C. 112 as provided in Paper 4.
8. The 35 U.S.C. 112 rejection to claim 15 in regard to the terms "each" and "white paper" has been withdrawn due to Applicant's arguments on page 4 of Paper 5.

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9. The 35 U.S.C. 112 rejection to claim 16 in regard to the term “Kraft” has been withdrawn due to Applicant’s arguments on page 5 of Paper 5.

10. The 35 U.S.C. 112 rejection to claim 18 in regard to the phrase “the paper sheet” has been withdrawn due to Applicant’s amendments in Paper 5.

11. The 35 U.S.C. 112 rejection to claim 20 in regard to the phrase “second paper sheet” has been withdrawn due to Applicant’s amendments in Paper 5.

REPEATED REJECTIONS

12. The 35 U.S.C. 103(a) rejection to claims 12-20 over Redmond in view of Finestone et al. has been repeated for the reasons previously made of record in paragraph 10 of Paper 4. As Applicant points out on page 4 of Paper 5, the amendments to the claims were made to address formalities; therefore, the 35 U.S.C. 103(a) rejection to claims 12-20 as provided in paragraph 10 of Paper 4 stands. The phrase “the surface energy of the film” is used in the 35 U.S.C. 103(a) rejection to claims 12-20 as provided in paragraph 10 of Paper 4. In regard to the phrase “a dilatable container” added to claim 12, it is stated in paragraph 10 of Paper 4 “Since the packages taught by Redmond are suited for packaging liquids, the laminate taught by the combination of Redmond and Finestone et al. is necessarily moisture resistant”; a dilatable container product (equivalently, the packages suited for packaging liquids taught by Redmond, see col. 2, lines 62-68 and col. 4, lines 32-34) made from the laminate sheeting necessarily “has moisture resistance” as claimed. Furthermore, since the laminate taught by the combination of Redmond and Finestone et al. has a high tear and burst strength as discussed on lines 3-22 of page 7 of Paper 4, a dilatable container product made from the laminate sheeting necessarily has high tear and burst strength. In regard to the added term “facing” in claim 18, lines 2-4 of page 10 of Paper 4 read

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“Finestone et al. also disclose that coated paper is used as the outer finish liner of corrugated paper board or labeling the board with printed data or to apply decorative graphics thereto”; therefore, the coated paper taught by Finestone et al. is used as a facing paper sheet.

NEW REJECTIONS

13. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 12, the term “enhanced” renders the claim indefinite; “enhanced” as compared to what? Page 4 of Paper 5 states that “the use of a paper sheet that is cold-laminated to two plastic films clearly provides enhanced tear and burst resistance compared to the paper sheet or sheets, a plastic film, or even a laminate of paper and plastic. However, this is not included in claim 12. Examiner also requests explanation as to how enhanced tear and burst resistance is “clearly” provided by cold-lamination as Applicant’s state in Paper 5.

Claim Rejections - 35 USC § 103

14. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redmond in view of Finestone et al.

Redmond and Finestone et al. teach the flexible plastic-paper-plastic laminate [sheeting] where each film is biaxially oriented as discussed in paragraph 10 of Paper 5.

In regard to claim 21, Redmond fails to teach that each film is polyester or polypropylene and the paper sheet comprises Kraft paper or a white or colored paper. However, Finestone et al. disclose that biaxially oriented polyester and biaxially oriented polypropylene are suitable materials for the plastic film (col. 5, lines 9-19 and col. 12, lines 29-30) and that Kraft paper is a

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suitable paper for the paper sheet (col. 10, lines 12-26) since corrugated paper board such as the paper sheet of Finestone et al. is commonly formed of Kraft paper (col. 1, lines 21-22). Finestone et al. teach that the plastic film is oriented or biaxially oriented to increase the tensile strength of the film (col. 5, lines 9-19). Therefore, one of ordinary skill in the art would have recognized to have used the oriented plastic film of Finestone et al. as the plastic layers of Redmond in order to increase the tensile strength of the plastic layers of Redmond as taught by Finestone et al. and to have used the Kraft paper of Finestone et al. as the paper layer of Redmond since paper layers in paper/plastic laminates are commonly formed of Kraft paper as taught by Finestone et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the oriented plastic film of Finestone et al. as the plastic layers of Redmond in order to increase the tensile strength of the plastic layers of Redmond as taught by Finestone et al. and to have used the Kraft paper of Finestone et al. as the paper layer of Redmond since paper layers in paper/plastic laminates are commonly formed of Kraft paper as taught by Finestone et al.

In regard to claims 22-25, Redmond and Finestone et al. teach the flexible plastic-paper-plastic laminate [sheeting] where each film is biaxially oriented as discussed in paragraph 10 of Paper 5 and above in the rejection to claim 21. Redmond fails to teach that an outer surface of one of the plastic films (in regard to claims 22 and 23) or both of the plastic films (in regard to claims 24 and 25) is/are surface treated to increase the surface energy of the film and its affinity to adhesives prior to lamination and that a facing sheet of paper is cold laminated to the treated outer surface/s of the plastic film/s, or that the facing sheet/s comprise/s Kraft paper, a white or colored paper, or a coated paper. However, Finestone et al. disclose that a second paper layer

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(item 17, Fig. 6) is laminated to plastic film 12 via water-based adhesive 13 and that the outer surface of plastic film 12 is treated in order to render the surface wettable (col. 7, line 66-col. 8, line 6). The second paper layer Finestone et al. is the facing sheet as claimed by Applicants. Finestone et al. also disclose that white paper or coated paper is used as the outer finish liner of corrugated paper board for labeling the board with printed data or to apply decorative graphics thereto (col. 1, lines 21-28). Since Finestone et al. teach the interchangeable use of corrugated paper board and planar paper (col. 7, lines 39-41), one of ordinary skill in the art would have recognized to have adhesively laminated the facing layer (second paper layer 17) of Finestone et al. to one, or both, of the plastic films of Redmond et al. in order to provide an outer paper layer or outer paper layers to the laminate of Redmond for labeling the laminate with printed data or for applying decorative graphics thereto as taught by Finestone et al.

ANSWERS TO APPLICANT'S ARGUMENTS

15. Applicant's arguments on pages 6-7 of Paper 5 regarding the 35 U.S.C. 103(a) rejection of claims 12-20 over Redmond in view of Finestone et al. have been fully considered but are not persuasive.

In response to Applicant's argument that "an oriented polymer film, as presently claimed, is not a sealant as disclosed by Redmond", Examiner states on lines 2-4 of page 6 of Paper 5 that "the sealant films 6 and 8 of Redmond are equivalent to the first and second reinforcing films as claimed by Applicants"; Examiner maintains this position. The fact that the sealant films 6 and 8 are separate layers unto themselves and are adhesively fixed to the paper layer (item 4) (col. 3, lines 34-51) qualifies the sealant films as reinforcing layers; any plastic film that is adhesively fixed to a paper film (regardless of the relative strengths of the plastic and paper films) would

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reinforce the paper film. As such, the sealant layers are indeed reinforcing layers, contrary to Applicant's arguments. Applicant then argues that "Redmond teaches away from the use of a plastic film of the type used and claimed by Applicants", supports this statement by pointing out that "Redmond describes the problems of a container formed of th[ese] plastic sheets, such as those used by applicants" and cites a passage from the first column of the Redmond patent, i.e. col. 1, lines 46-61. It is not seen exactly how "Redmond teaches away from the use of a plastic film of the type used and claimed by Applicants" given Applicant's support of this statement. Redmond describes the problems with containers formed from laminates of thin plastic and/or metal foil sheets that are sealed together (col. 14, lines 14-61). Redmond then states that these problems are overcome by Redmond's invention- a sheet of relatively flexible material over a sheet, web or card of relatively stiff but flexible material (col. 1, line 62-col. 2, line 2). As discussed in Paper 4, the material of the sheet of relatively flexible material is the sealant plastic and the sheet, material of the web or card of relatively stiff but flexible material is a paperboard paper sheet; this structure is equivalent to the structure claimed by Applicant. Redmond does not teach away from the laminate structure claimed by Applicants; Redmond teaches the laminate structure taught by Applicants. In the last full paragraph of page 6 of Paper 5, Applicant points out that the stiff material of Redmond "may be coated or covered with a sealant, such as a plastic"; the fact that the stiff material of Redmond "may be coated or covered with a sealant" is irrelevant because Redmond indeed teaches that the stiff material is coated or covered with a sealant. In this same paragraph in Paper 5, Applicant points out that Redmond teaches certain mechanical properties that the sealant "should" have, in regard to the response of the material to bending. Applicant claims that "a dilatable container product made from the laminate sheeting

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has moisture resistance and enhanced tear and burst strength”. One of ordinary skill in the art recognizes that the mechanical properties of a laminate in regard to the response of the laminate to bending are entirely different from the mechanical properties of a laminate in regard to the response of the laminate to burst pressure and tearing; i.e. the argument Applicant makes in regard to the certain mechanical properties that the sealant “should” have, in regard to the response of the material to bending, as taught by Redmond, is irrelevant. Applicant then points out that “Redmond alone cannot be used to reject the present claims” on page 7 of Paper 5; it is not seen why this statement was made since the claims were rejected not under 35 U.S.C. 102, but under 35 U.S.C. 103 in Paper 4.

Applicant then argues that “the combination of Redmond with Finestone et al. is not appropriate, since Redmond does not utilize oriented plastic films. Thus there is no relation between the Redmond and Finestone et al. patents that would lead one of ordinary skill in the art to the presently claimed invention.” Examiner disagrees. Both Redmond and Finestone et al. teach laminates that comprise at least one paper layer laminated to at least one plastic layer (note that Redmond specifically teaches that “the sealant is applied... as a film” to the relatively stiff material, item 4, paper) and not necessarily “as a liquid”, i.e. as a coating; this fact is sufficient “relation” to combine the references. Orientation is a notoriously well known means of strengthening any plastic film as taught by Finestone et al. One of ordinary skill in the art would have been motivated to have oriented the sealant films of Redmond in order to strengthen the film as one of ordinary skill in the art would have recognized that the plastic sealant films reinforce the paper layer as discussed above in the *Answers to Applicant’s Arguments* section of this Office Action (Paper #6).

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Applicants then argue that the two patents disclose different intended uses, i.e. different specific items intended to be enclosed in the package. This argument is irrelevant, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). Examiner wishes to point out that Applicant states that the laminate of Finestone et al. is useful for envelopes or other dilatable container products on page 7 of Paper 5 and that Applicants claim that the laminate sheeting as claimed is made into "a dilatable container product".

Applicants argue on page 7 of Paper 5 that the functionality of Redmond would be impaired upon substitution of the oriented films of Finestone et al. with the sealant films of Redmond because Redmond's package would be more difficult to open; this argument is irrelevant, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). Furthermore, this argument is not a valid argument because stretching the sealant films in one direction prior to lamination would make the laminate maximally difficult to tear in one direction along the planar surface of the laminate, but not along the direction perpendicular to this maximally difficult direction along the planar surface of the laminate.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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**WILLIAM P. WATKINS III
PRIMARY EXAMINER**